

REMARKS

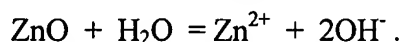
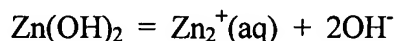
Claims 1-87 were pending in the application when last examined, of which claims 1-24 and 41-87 were withdrawn from consideration. Claims 25-40 were examined. Claims 1-24 and 41-87 are hereby canceled, and Claims 32, 33, 37, and 38 are amended.

Claim Rejections -- 35 USC § 112

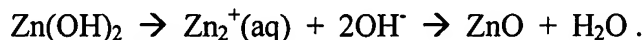
Claim 25 is rejected under 35 USC 112, first paragraph, for being non-enabling for inclusion of only zinc oxide or zinc oxide + zinc hydroxide in the final composition.

Claim 25 does not recite a method where the composition includes only zinc oxide.

As for enabling a combination of zinc oxide and zinc hydroxide, Applicant submits that there is adequate description to enable a person of ordinary skill in the art to make use of the invention. For example, Examples 1 and 2 make references to zinc hydroxide, and it would be understood by a person skilled in the art that some zinc oxide will be present in the disclosed compositions along with the zinc hydroxide. When zinc hydroxide is present in the composition, zinc oxide is inherently present because some zinc hydroxide converts to zinc oxide to establish an equilibrium between the two substances. Zinc hydroxide and zinc oxide are related thermodynamically by their solubility in water, as shown by the following equations:



It is well known that where two solid species may be linked via a set of thermodynamic equilibrium expressions, the least soluble solid will form progressively with time. Between zinc oxide and zinc hydroxide, zinc oxide has lower solubility. Consequently, zinc oxide will progressively form from a zinc hydroxide precipitate:



Claim 25 is rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated that it was unclear how the composition would include only zinc oxide. This rejection is moot in light of the above amendment to Claim 25.

Claim Rejections -- 35 USC § 103

Claims 25-32 are rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,827, 494 to Yano ("Yano") in view of U.S. Patent No. 4,297,249 to Przybyla ("Przybyla").

Claim 25 is patentable over Yano and Przybyla at least because it recites "A method of preparing a composition for use in preparing a zinc electrode" Yano, in contrast, teaches a method of preparing a *nickel* electrode (see Yano, col. 5, line 48). As Yano's goal is to prepare a nickel electrode, not a zinc electrode, Yano's method of preparation differs from the method recited in Claim 25.

Claim 25 is also patentable over Yano and Przybyla because it recites "preparing a first precipitate of zinc hydroxide." Although the Examiner stated that Yano's col. 5, lines 32-47 describes making an electrode by adding a precipitated zinc hydroxide with a salt of a mineral acid such as zinc sulfate, there is no reference to "preparing a first precipitate of zinc hydroxide" as recited in Claim 25. In fact, Yano uses a zinc hydroxide only in the form of a mixed crystal of zinc hydroxide with various other metal hydroxides, as listed in the cited section in Yano. The mixed crystal is used to coat the surface of nickel hydroxide particles, and those coated particles are used for preparation of a nickel electrode. A person skilled in the art would understand that the preparation of a mixed crystal of zinc hydroxide with one or two other metal hydroxides does not describe or suggest the preparation of a zinc hydroxide precipitate.

The Examiner states that Przybyla teaches adding an alkali metal salt of a fatty acid, including the metal of potassium and a fatty acid of stearic acid, forming potassium stearate. However, like Yano, Przybyla does not teach preparing a zinc electrode. Rather, Przybyla teaches preparing a silver oxide electrode (Przybyla, claim 1).

Claim 25 is patentable over Yano and Przybyla also because it states "nonreactively mixing a solution of an alkali salt ... with a suspension of the first precipitate...." Przybyla uses fatty acid or fatty acid salt to *react* with the silver oxide powder mixture (Przybyla, col. 2, line 65 - col. 3, line 5). This reaction between the fatty acid or fatty acid salt and the silver oxide powder mixture stands in stark contrast with the nonreactive mixing of the first precipitate and an alkali salt recited in Claim 25.

For the above reasons, Yano and Przybyla, even in combination, fail to teach or suggest all the elements of Claim 25.

Claims 32-40 are rejected under 35 USC 103(a) as being unpatentable over Yano in view of Przybyla, and further in view of U.S. Patent No. 4,146,685 to Tucholski ("Tucholski") and U.S. Patent No. 5,688,616 to Yamawaki ("Yamawaki").

Claims 32-40 depend from Claim 25, which is patentable over Yano and Przybyla for the reasons described above. Similarly, Claim 25 is also patentable over a combination of Yano, Przybyla, Tucholski and Yamawaki because neither Tucholski and Yamawaki discloses preparing a zinc electrode, "preparing a first precipitate of zinc hydroxide," or "nonreactively mixing a solution of an alkali salt ... with a suspension of the first precipitate," as recited in Claim 25. Since these elements are not taught in Yano, Przybyla, Tucholski, or Yamawaki, the four references, even in combination, do not teach or suggest all the elements of Claim 25.

Conclusion

Based on the above, Claims 25-40 are now in condition for allowance. Please feel free to contact the undersigned attorney at (650) 833-2121 if a telephone conversation would be useful to expedite the prosecution of this case.

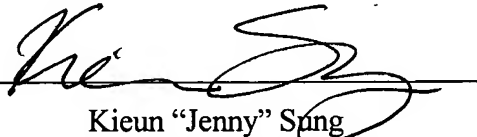
The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees to Deposit Account No. **07-1896** referencing Docket No. 358261-991100 (formerly 1772-000002). A duplicate copy of this paper is enclosed.

Respectfully submitted,

DLA PIPER RUDNICK GRAY CARY US LLP

Dated: May 2, 2006

By



Kieun "Jenny" Sung
Attorney for Applicant
Reg. No. 48,639

DLA PIPER RUDNICK GRAY CARY LLP

2000 University Avenue
East Palo Alto, CA 94303
Telephone: (650) 833-2121
Facsimile: (650) 833-2001
jenny.sung@dlapiper.com